

35 USC 102(e) REJECTIONS

Claims 1 - 4, 7 - 11, 14 and 15 are rejected under 35 USC 102(e).

The 35 USC 102(e) rejection is traversed. The patent to Abhyanker does not anticipate any one of the claims.

A combination is being claimed. A combination includes mechanical elements, substances in a composition and steps in a process. In re Fuetterer, 138 USPQ 217 (CCPA 1963).

To properly “anticipate” a claim a reference must: (A) be to the same invention; (B) have the same elements or steps with their meaning determined in light of the specification; (C) have all elements in exactly the same situation and united in the same way to perform the identical function in a single reference; (D) put the public in possession of the invention.

Anticipation requires the presence in a single prior art reference of each and every element of the claimed invention arranged as in the claim, and the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and identify corresponding elements disclosed in the alleged anticipation reference. 37 CFR 1.106(b); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co. et al, 221 USPQ 481 (CAFC 1984); In re Mullins, Wetherby and Chevalier, 179 USPQ 97 (CCPA 1973).

Unless all the elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference, there is no anticipation. Scott v. Inflatable Systems, Inc., 222 USPQ 460 (CA 9th Cir. 1983).

Before a reference can anticipate a claimed invention, that reference must put the public in possession of the claimed invention. The Patent Office has the initial burden. The applicant does not have to prove novelty to obtain a patent. Every limitation positively recited in the claim must be given effect in determining what subject matter that claim defines under 35 USC 102. In re Wilder, 166 USPQ 545 (CCPA 1970).

The patent to Abhyanker is not drawn to the same invention.

a) The Abhyanker publication is drawn to “resale” of used parts (0020 and 0038). The invention is drawn to selling unused or never before used material. A rejection under 35 USC 102 is proper only when the claimed subject matter is identically disclosed or described in the prior art, that is, all material elements recited in the claim must be found in one prior art unit to constitute an anticipation. In re Marshall 198 USPQ 344 (CCPA 1978).

b) The Abhyanker publication discloses that used parts that cannot be resold are scrapped or recycled (0040 and 0050). The invention discloses that new, unused material may be used by another thereby preventing it from ever becoming scrap. A reference which is not directed to the same purpose and does not have the same inventive concept as claims under consideration cannot be fairly applied in rejecting such claims. In re Luvisi and Nohejl, 144 USPQ 646 (CCPA 1965).

Your applicant has carefully reviewed the Abhyanker publication but fails to find any disclosure of materials, other than those recycled from parts not resalable, nor material size or material thickness. Abhyanker does not provide a repository for collecting “information on materials, sizes and thicknesses available by first fabrication parties” set forth in claim 1.

Abhyanker, as set forth in his claim 1, provides a reverse logistics by “offering used goods, owned by an actual seller, for sale over an internet exchange portal.” At no place within the disclosure of Abhyanker are specific materials or material sizes or material thicknesses addressed. Item 302 of Fig. 3 is merely an internet exchange portal (0038, lines 6 and 7) for previously used systems and parts. Abhyanker, In Fig. 4, does not disclose specific materials, material sizes or material thicknesses. Fig. 4 is a flow chart for auctioning off used systems and parts.

Claim 1 calls for a) providing a repository for collecting information on materials sizes and thicknesses; b) providing a repository for second user party material size and thickness needs; c) providing a means for communicating materials size and thickness available and needed between first and second parties; d) providing a means for receiving responses to materials’ size and thickness between first and second parties. Abhyanker does not address any one of a), b), c) or d), and thus does not anticipate or make obvious claim 1 or any of its dependent claims.

To anticipate a claim, a reference must teach each and every element of the claimed invention. Leinoff v. Louis Milona & Sons, Inc., 220 USPQ 845 (Fed.Cir 1984). The Court of Customs and Patent Appeals has reminded the Patent Office that all statements contained in any part of the claim, including the preamble, are to be considered as important and worthy of

consideration when an Examiner deliberates upon patentability. In re Duva, 156 USPQ 90 (CCPA 1967).

As to claim 2, Abhyanker does not teach processing offers for second parties to have work performed by second parties. Fig. 6 is a flow chart for auctioning off used goods in dependence on the condition of the used goods. In particular 618 is to refurbishment services. The designation 618 is addressed as being “limited to certain categories of used goods” (0066). The dictionary defines “refurbish” as “to make bright or fresh again, renovate.” The restoration of something to a state in which it is not now but once was at a prior time, is not a second party having work performed by a first party for formation of a specific material, size and thickness remaining from a first fabrication process.

The Examiner has in fact resorted to modifying the reference. A modification of the prior art references which is not taught by the references cannot be relied upon under 35 USC 102 or 103. Deering Milliken Research Corp. v. Beaunit Corp., 182 USPQ 421 (DCWNC 1974).

As to claims 3, 4, 9, 10, 14 and 15, negotiations per se are as old as commerce. These and tracking production and shipping and quality control are each per se standard procedures. The steps claimed are an integral part of claim 1 and the combination steps claimed there. There has been no valid showing that the combination of steps set forth are anticipated by or obvious over the prior art.

Anticipation requires the presence in a single prior art reference of each and every element of the claimed invention arranged as in the claim. Connell v. Sears, Roebuck & Co., 220 USPQ 193 (Fed Cir 1983); SSIH Equip. S.A. v. USITC, 218 USPQ 678 (Fed Cir 1983).

As to claims 7 and 8 and 11, each of these claims are specifically related to materials and sizes associated with new materials that would otherwise be scrap. These limitations are foreign to the Abhyanker publication and thus fail to teach the invention claimed.

It has been held that disclosures of prior patents must be read unaided by teachings of the subject matter which they are alleged to anticipate. Technical Tape Corporation v. Minnesota Mining and Manufacturing Company, 110 USPQ 160 (DCSDNY 1956). The Examiner is legally precluded from making even a slight modification when applying 35 USC 102 anticipation. Congoleum Industries v. Armstrong Cork, 173 USPQ148 (DC,E.D.Pa 1972).

As to the specific rejection of claim 8, i) the rejection inherently fails under 35 USC 102 since obviousness is not properly at issue; ii) there is no antecedent within the four corners of Abhyanker to use as a basis for modification of “scrap” since only previously used systems and parts are in issue there. Nothing in Abhyanker modifies anything from its original form; iii) the only scrap disclosed by Abhyanker is that sent to a landfill or salvage (0026, 0040); iv) the entire present patent application addresses the problem of making as much use as possible of a starting material to reduce scrap; v) the invention is to a specific procedure for new fabrications, not the mere opportunity to recoup losses from selling scrap. The invention is to prevent scrap.

To constitute an anticipation under 35 USC 102, a patent or publication must bear within its four corners adequate directions for practice of the subject matter for which it is being used as an anticipation. Dart Industries Inc. v. E. I. Du Pont De Nemours and Company, 175 USPQ 540 (DC ND Ill. E. Div. 1972); Illinois Tool Works Inc. v. Solo Cup Company, 179 USPQ 322 (DC ND Ill, E. Div. 1973). A prior publication, to anticipate, must be in such full, clear and exact terms so as to enable one skilled in the art to practice the improvement without the exercise of inventive skill of his own and without assistance from the subject matter which is being anticipated. Choat v. Rome Industries, Inc. et al., 203 USPQ 358 (DC ND Ga Rome Div. 1979).

As to the specific rejection of claim 9, Abhyanker does not reduce scrap. He scraps any used parts he cannot sell. The Examiner has engaged in a hindsight reconstruction of the prior art.

Prior art patents are measured as anticipations by what is clearly and definitely expressed in them; they may not be reconstructed in light of the invention in suit and given significance and importance which they did not have in the art. They may not be reconstructed in light of later acquired knowledge and then used as part of the prior art; the basic question is what does the cited reference itself say. Weller Manufacturing Co. v. Wen Products, Inc., 101 USPQ 14 (DC Ill 1954); Wesslau 147 USPQ 391 (CCPA 1965).

The present rejections ignore the well established criteria for patentability determination.

The totality of the prior art and invention have not properly been considered. The totality of the prior art leads away from the claimed invention. In re Hedges et al, 228 USPQ 685 (CAFC 1986).

The process disclosed by Abhyanker and that presently claimed are not the same. In considering the question of invention, it is necessary to determine whether or not the art relied upon contains adequate directions for the practice of the invention without resort to the involved application. In re Gibbons, 100 USPQ 398. The mere existence of basic teachings in the prior art (here internet information exchange) does not render obvious a new claim combination of such teachings since a claim combining prior art elements (here steps) can embody a patentable invention if it represents progress in the prior art. When the art is advanced, the court must be liberal in the construction of a patent so as to secure the inventor a reward which he deserves. Meredith Corp. v. Harper & Row, 182 USPQ 577 (CA 2d Cir 1974). A combination rejection must be supported by something other than applicant's own disclosure. In re Shaffer, 108 USPQ 326 (CCPA 1956).

The steps disclosed by Abhyanker and those presently claimed are not the same. Even if steps of the process were performed separately in the prior art, this would not render obvious combining them into one process absent an indication it would have been obvious to do so. Fromson v. Advance Offset Plate, Inc., 225 USPQ 26 (CAFC 1985).

The materials being considered by Abhyanker (used equipment) and those presently being claimed (product fabrication material) are not the same. Process claims may not be rejected merely because they are directed to the use of a new material in an old process. Ex parte Rue et al, 155 USPQ 474 (POBA 1967). The ultimate legal conclusion of obviousness must be based on facts or records, not on the examiner's unsupported allegation that a particular structural modification is "well known and thus obvious." Subjective opinions are of little weight against contrary evidence. In re Wagner et al, 152 USPQ 552 (CCPA 1967).

The Examiner has resorted to modifying the teachings of both Abhyanker and the present invention. It is not proper use of a reference to modify its structure (and/or steps) to one which prior art references do not teach. In re Randal et al, 165 USPQ 586 (CCPA 1979).

The Examiner has ignored the simple meanings of words to equate the teachings of Abhyanker with those of the invention. The examiner is required to consider all the words of a claim in judging the patentability of a claim against the prior art. In re Miller, 169 USPQ 597 (CCPA 1971). The Federal Circuit has stated that a term in a claim is to be given a construction consistent with the ordinary meaning of the term and also consistent with the intrinsic evidence from the patent itself. Hill-Rom v. Kinetic Concepts & KCI Therapeutic Servs., No. 99-1314 (Fed Cir Apr. 14, 2000). The requirements of a claim cannot simply be ignored. In re Ehhreich et al, 200 USPQ 504 (CCPA 1979). All apparently limiting language in a claim must be considered material absent external evidence suggesting otherwise. Ontario Die of America v. Independent Die Ass., 18 USPQ 2d 1477 (DCE Mich 1990). All limitations of a claim must be

considered in determining the claimed subject matter and it is error to ignore specific limitations distinguishing over a reference. In re Boe, 184 USPQ 38 (CCPA 1974).

The Examiner has rejected the claims based on personal opinions rather than facts of record. The mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an applicant to prove conclusively that the Patent Office is wrong. In re Soli, 137 USPQ 797 (CCPA 1963). To assign attributes to the references which do not, in fact, exist, and to entirely discount the critical language within the claim does not comply with the requirements of objectively identifying the differences between the claimed invention and the prior art. In re Wood and Everrole, 202 USPQ 17 (CCPA 1979). The Court of Appeals for the Federal Circuit has stated that the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of those findings. In re Zurko, 258 F.3d 1379 (FedCir 2001).

The erroneous interpretation of Abhyanker and the invention can only be the result of hindsight. More than an opinion or speculation and hindsight are required to reach a legal conclusion of obviousness. In re Sporck, 133 USPQ 360 (CCPA 1962). To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record suggest that knowledge is hindsight where that which only the inventor taught is used against its teacher. W. L. Gore & Associates v. Garlock 220 USPQ 303 (CAFC 1983).

Claims 1 - 4, 7 - 11, 14 and 15 are not anticipated by Abhyanker and are believed to be in condition for allowance.

35 USC 103 REJECTIONS

Claims 5, 6, 12, 13, 16 and 17 are rejected under 35 USC 103(a) as being unpatentable over Abhyanker in view of Official Notice.

The patent to Abhyanker does not render the claims obvious, the Examiner's opinion notwithstanding. The disclosures are not directed to the same invention. The present claims are directed to a scrap reduction procedure from a new material. Abhyanker's claims and invention are directed to resale of used goods. The differences are pointed out in the Remarks addressing the 35 USC 102 rejection. A series of process steps are in issue, not a collection of random sales devices used in commerce. The steps relate to a scrap reduction not disclosed by Abhyanker.

The steps involved are different in the claims (inventions) with examples being:

Abhyanker requires used goods owned by a seller, selling the right to market the used goods to a virtual seller, marketing the used goods under the direction of the virtual seller. The present invention provides a repository for collecting information on materials available by a fabrication party, providing a repository for information on needs of second parties, and providing a means for communicating the information between the parties. The information of interest in the two inventions are different with examples being that Abhyanker is interested in selling used systems and parts while the present invention is interested in reducing scrap after fabrication of an

element by listing materials, sizes and thickness available remaining after the first fabrication for fabrication of other new products by or for a second party.

For these, and the other reasons enumerated in the 35 USC 102(e) rejections, claims 1 - 4, 7 - 11, 14 and 15 are allowable. Since all of claims 5, 6, 12, 13, 16 and 17 depend from allowable claim 1, they are patentable. In re Fine, 5 USPQ 2d 1596 (FedCir 1988).

As to claim 5, the Examiner erroneously states “Abhyanker teaches bids and performing secondary fabrication (FIG 6).” Abhyanker does not teach a first or a second fabrication. As previously pointed out, Abhyanker only teaches “refurbishment service.” There is a significant difference between a fabrication process, the manufacture of a new product, and a “refurbishment process,” the restoration of an old product back to or near to its original form. This alone defines patentability over the teachings of Abhyanker.

Claim 5 also requires “responses in the form of bids by a first party fabricating work products.” While “bids” per se may be obvious in commerce, the full circumstances required by the process step, alone or without the combination, are not obvious or subject to an opinion under the guise of an Official Notice. This is only in addition to “tabulating bids to fabricate work products ... to fabricate to a second party.”

The Examiner is addressing phantom issues that are irrelevant insofar as the claim is concerned. No Official Notice can overcome this deficiency in the teachings of Abhyanker.

As to claim 7, the Examiner again erroneously states that Abhyanker teaches “bids by a said second party for having work products fabricated.” As with claim 5, there can be no Official Notice on the phantom issues addressed by the Examiner.

As to claims 12 and 13, the assistance and credit check are included as steps in a process that goes well beyond a rejection under 35 USC 103 based on Official Notice.

As to claim 16, Abhyanker does not teach communicating materials and sizes available and needed and quality review and thus the claims are patentable per se. The negotiations, credit checks, assistance and tracking are all additional steps in the process that hardly can collectively be rendered obvious by an Official Notice.

As to claim 17, Abhyanker does not teach quality control because there is no need for control quality as there is nothing manufactured. Any need for quality control of Abhyanker’s used parts would have to have been addressed when the parts were originally fabricated by an original fabricator. The claim is not properly subject to an Official Notice taken with Abhyanker of a simple gap filling element or step.

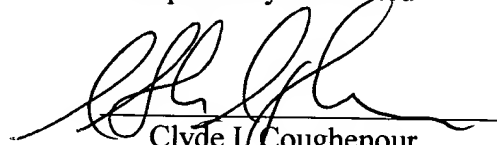
Where a sequence of steps or the results obtained thereby is not suggested by the prior art, a multi-step process is patentable even if the individual steps are taught. Ex parte Bariel et al 124 USPQ 509 (POBA 1958). In re Chandler et al 138 USPQ 138 (CCPA 1963).

Claims 5, 6, 12, 13, 16 and 17 are not obvious and are allowable with claims 1 - 4, 7 - 11, 14 and 15.

CONCLUSION

The rejections do not comply with the requirements established for 35 USC 102 and 35 USC 103 rejections. The claims are believed to be in condition for allowance and such action is respectfully requested.

Respectfully submitted



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